



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,577	04/08/2004	William Hazen Hildebolt	26365-030	9072
36614 7590 03/11/2009 MANATT PHELPS AND PHILLIPS ROBERT D. BECKER 1001 PAGE MILL ROAD, BUILDING 2 PALO ALTO, CA 94304				
EXAMINER ALATA, YASSIN				
ART UNIT		PAPER NUMBER		
2427				
MAIL DATE		DELIVERY MODE		
03/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/821,577

Applicant(s)

HILDEBOLT ET AL.

Examiner

YASSIN ALATA

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Objections

1. Claim 14 is objected to because of the following informalities:

Claim 14 recites "privacy guaranty" it seems that there is a misspelling. The Examiner suggests correcting it to --privacy guarantee--.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim(s) 1-27 and 33 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and represent an Abstract idea [see CAFC decision *In re Bilski*, F.3d, 88 USPQ 2d 1385 (2008)] and therefore do not qualify as a statutory process.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wingard (US 2003/0041104) in view of Alexander (US 6,177,931).

Regarding claim 1, Wingard discloses a method of providing a programming channel (shopping channel; Fig. 5) comprising the steps of:

(a) collecting prerecorded advertising segments from third parties (advertisement server 114 provide advertisement; paragraph 0032 and Fig. 1. Furthermore, ads must be stored and sent to content source 104; paragraph 0032);

(b) overlaying additional information onto the advertising segments (template 500 has fields that have been populated with text and graphics...banner 501..interactive ads; Paragraph 0070. Furthermore, please see provisional application 60/310,851 incorporated by reference; paragraph 1, a copy was provided for the convenience of the Applicant. See the provisional application for more overlaying such as sponsor logo; page 10, "request info" in Fig. 17 and "buy now", "channel sponsorship" and integrated content opportunities in page 18);

(c) introducing the resulting advertising from step (b) into programming to substantially fill a programming day (shopping channel is programming and it is on all the time; Fig. 2D);

- (d) committing the shopping channel to a schedule (Fig. 2D, i.e. channel 950 is a shopping channel and it is on all the time);
- (e) providing the programming schedule to a programming guide service to include entries of the schedule into the guide for consumers (EPG data includes information about the shopping channel; Fig. 2D and the shopping channel entry is displayed in the EPG 412; Fig. 4 and paragraph 0069); and
- (f) distributing the programming to media outlets (internet distribution; paragraph 0034-0035).

Wingard discloses ads in general and committing the channel to a schedule as in step d, but Wingard doesn't disclose that those ads are long form or video infomercials and committing the programming to a schedule.

However, Alexander, in the same field of endeavor, discloses an improvement EPG that provides among other things producers of infomercials to reach the viewers through Virtual channel ad slots; Abstract and col. 22, lines 20-34. Furthermore, Alexander discloses committing the programming to a schedule (virtual channel ad slots are displayed in the EPG as rows in the grid guides schedule of programs; col. 22, lines 20-34 and col. 26, lines 36-45).

Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify Wingard by the teachings of Alexander to have infomercials in the shopping channels because infomercials are a form of ads, and committing the infomercials to a schedule to be able to watch infomercials in the

shopping channel and to record or schedule for watching infomercials; col. 22, lines 20-34.

Regarding claim 2, Wingard in view of Alexander further disclose the method of claim 1, wherein the programming is sufficient to substantially fill a 24 hour day of programming (Wingard; Fig. 2D and Alexander; library of advertisements must have a lot of advertisements; col. 34, lines 10-25).

Regarding claim 3, Wingard in view of Alexander further disclose the method of claim 1, wherein the video is long form (it is obvious that infomercials are long form; Alexander; if ad duration is incremented by 60 seconds it can produce a very long infomercial; col. 26, lines 36-45 and ad slots 52 in Fig. 1 are long).

Regarding claim 4, Wingard in view of Alexander further disclose the method of claim 1, wherein the programming is distributed via the Internet (Wingard; Fig. 1 and Alexander; col. 8, lines 36-64).

Regarding claim 5, Wingard in view of Alexander further disclose the method of claim 1, wherein the entries in the media programming guide are listed in congruous order (Alexander; in order and within time slots; Fig. 1 row 52).

Regarding claim 6, Wingard in view of Alexander further disclose the method of claim 1, wherein the programming segments are loaded onto servers for video-on-demand (Alexander; servers for video on demand is interpreted as being external database, a web site, head end or data services for requesting advertisements when desired by the user; col. 18, lines 1-12 and col. 34, lines 10-25. Furthermore, Wingard disclose the shopping channel, and when it desired the user can tune to that channel from the EPG and watch ads).

Regarding claim 7, Wingard in view of Alexander further disclose the method of claim 6, wherein related archived prerecorded video advertising segments are also loaded onto the servers (Alexander; library of advertisements stored at the head end; col. 34, lines 10-25).

Regarding claim 8, Wingard in view of Alexander further disclose the method of claim 7, wherein after step (a) an additional step is to conduct research on the product or services or the advertiser (Alexander; conducting a research on the product is interpreted as being collecting and analyzing the user profile; col. 29, lines 12-67. Furthermore, Wingard; paragraph 0025).

Regarding claim 9, Wingard in view of Alexander further disclose the method of claim 1, wherein the programming guides are in electronic form (EPG stand for electronic program guide).

Regarding claim 10, Wingard in view of Alexander further disclose the method of claim 1, wherein the programming channel is promoted on other channels (met by having a short ad in any channel for the shopping channel which can be done by inserting ad in any channel using ad insertion methods very known in the art).

Regarding claim 11, Wingard in view of Alexander further disclose the method of claim 1, wherein the additional information being overlaid is directly related to the product or services being advertised (Wingard; See the provisional application for more overlaying such as sponsor logo; page 10, "request info" in Fig. 17 and "buy now", "channel sponsorship" and integrated content opportunities in page 18 and Alexander; I icon is provided by the service being advertised, i.e. the advertiser and text with combination with graphics related to the ads; col. 24, lines 41-67 and col. 26, lines 19-30).

Regarding claim 12, Wingard in view of Alexander further disclose the method of claim 1, wherein a series of prerecorded video advertising segments directed to a plurality of products, services or products and services that are thematically related are combined and distributed within a given time block of the schedule for the programming channel (Wingard; Top ten DVD rentals are related and combined; page 18 and Alexander; if the user selects sports as a theme, advertisement for automobile would be

selected for display. Furthermore, the history of the user is analyzed and used to decide which ads to display; col. 34, lines 31-67).

Regarding claim 13, Wingard in view of Alexander further disclose the method of claim 12, wherein the time block ranges from about 30 to about 120 Minutes (infomercials are long form. Furthermore ad duration is increment of typically 60 seconds...so 60 sec incremented 30 times = 1800 sec = 30 minutes and the same for 120 minutes; Alexander; col. 26, lines 36-45).

Regarding claim 14, Wingard in view of Alexander further disclose the method of claim 1, wherein the perspective consumer is provided with a privacy Guarantee (Wingard; provisional application; all transactions are conducted using SSL payment is safely stored and passed to merchant; page 20 and Alexander; parental control and password protection must provide the user with privacy; col. 17, lines 13-25).

Regarding claim 15, Wingard in view of Alexander further disclose the method of claim 1, wherein a potential consumer orders the products or services directly from or through the programming channel (Wingard; see provisional application ; pages 18, 20-21 and Alexander; impulse buying and buying habits; col. 30, lines 17-37).

Regarding claim 16, Wingard in view of Alexander further disclose the method of claim 1, wherein additional information appears as a strip of textual information overlaid

across the video advertising (Wingard; see provisional, i.e. Top ten DVD rentals; page 18 and Alexander text with combination with graphics related to the ads; col. 24, lines 41-67).

Regarding claim 17, Wingard in view of Alexander further disclose the method of claim 1, wherein additional information appears as a pop-up of textual information overlaid onto the video advertising (impulse buying must involve a kind of a pop-up message over the advertisements; Wingard; see provisional page 19 and Alexander; col. 30, lines 17-37).

Regarding claim 18, Wingard in view of Alexander further disclose the method of claim 15, wherein demographic information on the potential consumer is collected and sent to the programming channel (Wingard; paragraph 0025 and Alexander; collecting and analyzing the user profile; col. 29, lines 14-67).

Regarding claim 19, Wingard in view of Alexander further disclose the method of claim 18, wherein the distribution is via video-on-demand (Alexander; distribution via video on demand is interpreted as being distributing ads from external database, a web site, head end or data services when desired by the user; col. 18, lines 1-12 and col. 34, lines 10-25).

Claim 20 is rejected on the same grounds as claim 1, wherein step (b) is met by the analysis of claim 8 and step (f) has extra limitation which is the programming guide specifically indicating the product or types of products to be broadcast over the channel is met by Alexander Fig. 1. wherein ad slot 52 shows the infomercial type; col. 22, lines 20-34.

Claim 21 is rejected on the same grounds as claim 11.

Regarding claim 22, Wingard in view of Alexander further disclose the method of claim 20, wherein the additional information is related to the advertiser (Wingard; provisional; page 15 and 16).

Regarding claim 23, Wingard in view of Alexander further disclose the method of claim 20, wherein additional information is related to the research conducted in step (b) (all ads in Alexander are related to the user profile; col. 29, lines 14-67).

Claim 24 is rejected on the same grounds as claim 1.

Claim 25 is rejected on the same grounds as claim 11.

Claim 26 is rejected on the same grounds as claim 22.

Claim 27 is rejected on the same grounds as claim 23.

Claim 28 is rejected on the same grounds as claim 1, wherein:

Infomercial programming channel via video on demand is interpreted as being the shopping channel tuned to any time by the user, and a central computer system, a video editing, an assembler for identifying and cataloging each of the resulting video advertising segments, a communication system and the media outlets selected from the group consisting of television, video-on-demand, Internet, and set-top box are met by (Wingard; the system in Fig. 1);

Claim 29 is rejected on the same grounds as claim 28. wherein for interactivity with a potential consumer is met by (Wingard; Fig. 5 and Fig. 6; see provisional also for interactivity, i.e. page 14-21).

Claim 30 is rejected on the same grounds as claim 29, wherein a device to allow a potential consumer to browse the infomercial programming via a plurality of pathways is met by Wingard; set-boxes via the internet which is the network of networks; Fig. 1 and paragraph 0033.

Regarding claim 31, Wingard in view of Alexander further disclose the system of claim 30, wherein said device allows potential consumer to browse the infomercial programming via a plurality of VOD navigation screens (Wingard; Fig. 5 and Fig. 6; see provisional also for interactivity, i.e. page 14-21).

Regarding claim 32, Wingard in view of Alexander further disclose the system of claim 31, wherein the superimposed information includes verification of privacy (it is obvious to display such notification when using the Secure Sockets Layer or the SSL; see Wingard; provisional; page 20), return policies (basic feature and obvious when shopping online; Wingard; provisional; page 6), guaranty/warranty (basic features and obvious when shopping online; Wingard; provisional; page 6), and information on the history of the product or services (Wingard; provisional; page 15).

Claim 33 is rejected on the same grounds as claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YASSIN ALATA whose telephone number is (571)270-5683. The examiner can normally be reached on Mon-Fri 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on 571-272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Y. A./
Examiner, Art Unit 2427

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427